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EXAMINER

SRIVASTAVA, VIVEK

ART UNIT PAPER NUMBER

2611

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,183

Applicant(s)

BROTZ ET AL.

Examiner

Vivek Srivastava

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. US 6,374,404. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to get the claims in the instant application by modifying patent 6,374,404.

Claim 1 in the instant application corresponds to claim 1 in patent 6,374,404. Since claim 1 in the instant application is a broader recitation of claim 1 in patent 6,374,404, it would have been obvious to modify claim 1 in patent 6,374,404 to get claim 1 in the instant application.

Claim 2 in the instant application corresponds to claim 2 in patent 6,374,404. Since claim 2 in the instant application is a broader recitation of claim 2 in patent 6,374,404, it would have been obvious to modify claim 2 in patent 6,374,404 to get claim 2 in the instant application.

Claim 3 in the instant application is identical to claim 3 in patent 6,374,404.

Claim 4 in the instant application is identical to claim 4 in patent 6,374,404.

Claim 5 in the instant application is identical to claim 5 in patent 6,374,404.

Claim 6 in the instant application is identical to claim 6 in patent 6,374,404.

Claim 7 in the instant application is identical to claim 7 in patent 6,374,404.

Claim 8 in the instant application corresponds to claim 1 in patent 6,374,404. Since claim 8 in the instant application is a broader recitation of claim 1 in patent 6,374,404, it would have been obvious to modify claim 1 in patent 6,374,404 to get claim 8 in the instant application.

Claim 9 in the instant application corresponds to claim 1 in patent 6,374,404. Claim 9 in the instant application recites the same limitations as claim 1 in patent 6,374,404. Steps b1) and b2) in the instant application equates to steps b1) and b2) in patent 6,374,404. Claims b1) and b2) in the instant application recites:

b1) sequentially scanning a first tuner of said digital television system over channels of said digital television broadcast signal for a predetermined time period for each scanned channel' and

b2) at each scanned channel, identifying newly received hypertext documents;

Whereas steps b1) and b2) in patent 6,374,404 recites:

b1) tuning a tuner to a selected channel within said digital television broadcast signal and receiving datacast information therefrom for a time period:

b2) identifying newly received hypertext documents from datacast information is step b1):

It would have been obvious to include steps b1) and b) as recited in the instant application to claim 1 of the patent 6,374,404 to scan the all the channels in the digital television broadcast signal for a predetermined time to locate all the hypertext documents in all of the television channels. Therefore, it would have been obvious to include the claimed limitations to ensure all the hypertext documents are located by sequentially scanning all the television channels for a pre-determined amount of time.

Claim 10 in the instant application corresponds to claim 1 in patent 6,374,404, however, claim 1 in patent 6,374,404 fails to recite a second tuner of said digital television system to display contents of a selected channel to said viewer on said display screen. However, it would have been obvious to modify claim 1 in 6,374,404 to include the claimed second tuner to provide faster tuning by employing a two-tuner system.

Claim 11 in the instant application is identical to claim 2 in patent 6,374,404.

Claim 12 in the instant application is identical to claim 3 in patent 6,374,404.

Claim 13 in the instant application is identical to claim 4 in patent 6,374,404.

Claim 14 in the instant application is identical to claims 5 and 6 in patent 6,374,404.

Claim 15 in the instant application is identical to claim 7 in patent 6,374,404.

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Claim 16 in the instant application corresponds to claim 8 in patent 6,374,404.

Since claim 16 in the instant application is broader recitation of claim 8 in patent 6,374,404, it would have been obvious to modify claim 8 of patent 6,374,404 to get claim 16 in the instant application.

Claim 17 in the instant application is identical to claim 9 in patent 6,374,404.

Claim 18 in the instant application is identical to claim 10 in patent 6,374,404.

Claim 19 in the instant application is identical to claim 11 in patent 6,374,404.

Claim 20 in the instant application is identical to claim 12 in patent 6,374,404.

Claim 21 in the instant application is identical to claim 13 in patent 6,374,404.

Claim 22 in the instant application is identical to claim 14 in patent 6,374,404.

Claim 23 in the instant application corresponds to claim 8 in patent 6,374,404.

Since claim 23 in the instant application is a broader recitation of claim 8 in patent 6,374,404, it would have been obvious to modify claim 8 in patent 6,374,404 to get claim 23 in the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 7, 16, 17, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (US 6,351,467) in view of Hidary et al (US 5,774,664).

Regarding claim 1, Dillon discloses a system and method for displaying information in a digital television system (col 8 lines 22 – 25). Dillon discloses transmitting URL's of interest in channels to a user's receiver. It is noted that URL's comprise hypertext transfer protocol HTTP (see col 22 lines 30 – 38). Dillon further discloses receiving updated URL information (see col 11 lines 19 – 30) and performing URL lookup (see col 22 lines 55 – 61) and thus discloses the claimed 'monitoring datacast information decoded from a digital television broadcast signal to identify newly received hypertext documents'. Dillon still further discloses storing into a cache memory an newly received URL's (see col 22 lines 23 – 30), receiving from a viewer a identifier of a selected hypertext document (see col 21 line 66 – col 22 line 31), and providing offline browsing if detecting that the URL is located in the cache memory (see col 21 line 66 – col 22 line 31) on a display screen of the digital television system (see col 8 lines 22 – 26 and col 16 lines 1 – 8).

Although Dillon discloses filtering documents according to user preferences, Dillon fails to disclose maintaining an intelligent filter that records hypertext documents that were previously accessed by a viewer.

In analogous art, Hidary teaches system for receiving personalized URL's based on a user's history or behavior. It is noted that the system of Hidary inherently comprises filter to filter out preferred URL's from non-preferred URL's based on a

recorded user's history or behavior. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dillon to include the claimed limitation to provide a user with URL's which a user most desires.

Regarding claim 2, Dillon discloses the URL's may be frequently updated (see col 11 lines 19-25) over the CATV network (see col 16 lines 5 – 7) and thus discloses the claimed 'datacast information comprises a domain of hypertext documents that are periodically broadcast.

Regarding claim 4, Dillon discloses if the content is not located in the cache, a user can retrieve the content from the Internet (see col 23 line 37 – col 24 line 30) via dialup modem (see col 23 line 5 – 17).

Regarding claim 7, Dillon discloses wherein the identifiers are web page identifiers (URL's) and discloses the hypertext documents are URL's but the combination of Dillon and Hidary fails to disclose the claimed wherein the hypertext documents are web pages.

Official Notice is taken that pre-caching of web pages is well known to enable having web pages readily available. Therefore, it would have been obvious to one having ordinary skill in the art to modify the combination of Dillon and Hidary to cache web pages to enable having web pages readily available.

Regarding claim 16, Dillon discloses a display screen (see 'digital television' in col 8 lines 22 – 25) noting that the television inherently comprises a tuner. Dillon further inherently discloses the claimed 'intelligent controller coupled to the display screen and coupled to the tuner, the intelligent controller comprising a processor coupled to a bus

and a memory unit containing instructions that when executed implement a method of displaying information' since a controller, memory and some kind of communication path i.e. bus must be included to convey and implant instructions for the processing of the received URL's. It is noted that steps a – e are identical to steps a – e in claim 1 and are rejected for the same reasons provided above.

Claims 17, 19 and 22 are met by the discussions above.

Claims 3 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (US 6,351,467) in view of Hidary et al (US 5,774,664) as applied to claims 1 and 16 above, and further in view of Broadwin (US 5,929,850).

Regarding claims 3 and 18, the combination of Dillon and Hidary fails to disclose the claimed provided the selected hypertext document is not located within the cached memory, obtaining the selected hypertext document upon its next occurrence.

Broadwin discloses the claimed provided the selected hypertext document is not located within cache memory, obtaining selected hypertext document upon its next occurrence (broadcasted via the still image channel) within datacast information and displaying selected hypertext document on display screen of digital television system (col. 11 line 58 - col. 12 line 13).

It would have been obvious modifying the combination of Dillon and Hidary to include the claimed limitation would have enabled automatically obtaining the URL during a subsequent broadcast thus providing the user with desired URL. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention

was made to modify the combination of Dillon and Hidary to include the claimed limitation to automatically provide a user with the selected URL.

Claims 5, 6, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (US 6,351,467) in view of Hidary et al (US 5,774,664) as applied to claims 1 and 16 above, and further in view of Burns et al (US 5,991,306).

Regarding claims 5, 6, 20 and 21, the combination of Dillon and Hidary fails to disclose receiving and recording identifiers of hypertext documents accessed by said viewer, recording a count associated with each identifier received by step a1), said count indicating the number of times each recorded hypertext document was accessed by said viewer, ranking identifiers of said intelligent filter based on their associated counts and removing from intelligent filter any recorded identifier of a hypertext documents that has not been accessed by said viewer for a predetermined amount of time.

In analogous art, Burns teaches a system which pre-caches frequently requested web-pages to reduce latency by having the web-pages readily available (see col 10 lines 11 – 15). Burns further teaches a hit record which records hits for a particular web-page to provide a means for determining the popularity of a web-page based on a user's behavior patterns (see col 8 lines 41 – 60). Burns still further teaches that the subscriber's patterns or out-of-date rules can be used to delete content from a cache noting the storage capacity limitations associated with cache memory (see col 10 lines

48 – 58 and col 11 lines 15 – 32). It is noted that by associating the number of hits (counting of hits) with content provides for the prioritization and thus ranking of what content is frequently requested from that which is not frequently requested.

It would have been obvious modifying the combination of Dillon and Hidary to include steps a1) – a4) would have provided ranking of URL's in the cache memory to separate frequently requested URL's from non-frequently requested URL's resulting in the reduction in storage capacity limitations in the cache by allocating more space to more popular more frequently requested URL's. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Dillon and Hidary to include the claimed limitations to reduce storage capacity limitations in the cache.

Claims 9 – 11, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (US 6,351,467) in view of Hidary et al (US 5,774,664) and Williams (US 5,701,161).

Regarding claim 9, steps a, b, c, d, and e recite the limitations as claims 1 and 16 and are rejected based on the reasoning provided above.

Although Dillon discloses a CATV system (which inherently comprises channels) and checking or searching channels for content (see col 22 lines 55 – 61), Dillon fails to disclose step b1) sequentially scanning a first tuner of said digital television system over channels of said digital television broadcast signal for a predetermined time period for

each scanned channel and step b2) at each scanned channel, identifying newly received hypertext documents.

Williams teaches scanning a plurality of channels to retrieve desired data (col. 5 line 65 - col. 6 line 19). It would have been obvious to sequentially scan the plurality of channels as claimed to detect all URL's thereby providing a more comprehensive search and retrieval of all the URL's. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to sequentially scan the first tuner as claimed to detect and identify all URL's thereby providing a more comprehensive method and system for retrieving URL's.

Regarding claim 10, the combination of Dillon, Hidary and Williams fails to disclose the claimed limitation. Official notice is taken that the user of two tuners is notoriously well known in the television art for providing PIP capabilities or for providing a quicker means for tuning to another channel. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Dillon, Hidary and Williams to include the claimed limitation to provide PIP capabilities for displaying the URL's or to provide faster detection and display of a URL by employing a two tuner system.

Regarding claim 11, Dillon discloses the claimed limitation as discussed above.

Regarding claim 13, Dillon discloses the claimed limitation as discussed above.

Regarding claim 15, Dillon discloses wherein the identifiers are web page identifiers (URL's) and discloses the hypertext documents are URL's but the

combination of Dillon, Hidary and Williams fails to disclose the claimed wherein the hypertext documents are web pages.

Official Notice is taken that pre-caching of web pages is well known to enable having web pages readily available. Therefore, it would have been obvious to one having ordinary skill in the art to modify the combination of Dillon and Hidary to cache web pages to enable having web pages readily available.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (US 6,351,467) in view of Hidary et al (US 5,774,664) and Williams (US 5,701,161) as applied to claim 9 above, and further in view of Broadwin (US 5,929,850).

Regarding claim 12, the combination of Dillon, Hidary and Williams fails to disclose the claimed provided the selected hypertext document is not located within the cached memory, obtaining the selected hypertext document upon its next occurrence.

Broadwin discloses the claimed provided the selected hypertext document is not located within cache memory, obtaining selected hypertext document upon its next occurrence (broadcasted via the still image channel) within datacast information and displaying selected hypertext document on display screen of digital television system (col. 11 line 58 - col. 12 line 13).

It would have been obvious modifying the combination of Dillon, Hidary and Williams to include the claimed limitation would have enabled automatically obtaining the URL during a subsequent broadcast thus providing the user with desired URL.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Dillon and Hidary to include the claimed limitation to automatically provide a user with the selected URL.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (US 6,351,467) in view of Hidary et al (US 5,774,664) and Williams (US 5,701,161) as applied to claim 9 above, and further in view of Burns et al (US 5,991,306).

Regarding claim 14, the combination of Dillon and Hidary fails to disclose receiving and recording identifiers of hypertext documents accessed by said viewer, recording a count associated with each identifier received by step a1), said count indicating the number of times each recorded hypertext document was accessed by said viewer, ranking identifiers of said intelligent filter based on their associated counts and removing from intelligent filter any recorded identifier of a hypertext documents that has not been accessed by said viewer for a predetermined amount of time.

In analogous art, Burns teaches a system which pre-caches frequently requested web-pages to reduce latency by having the web-pages readily available (see col 10 lines 11 – 15). Burns further teaches a hit record which records hits for a particular web-page to provide a means for determining the popularity of a web-page based on a user's behavior patterns (see col 8 lines 41 – 60). Burns still further teaches that the subscriber's patterns or out-of-date rules can be used to delete content from a cache noting the storage capacity limitations associated with cache memory (see col 10 lines

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48 – 58 and col 11 lines 15 – 32). It is noted that by associating the number of hits (counting of hits) with content provides for the prioritization and thus ranking of what content is frequently requested from that which is not frequently requested.

It would have been obvious modifying the combination of Dillon and Hidary to include steps a1) – a4) would have provided ranking of URL's in the cache memory to separate frequently requested URL's from non-frequently requested URL's resulting in the reduction in storage capacity limitations in the cache by allocating more space to more popular more frequently requested URL's. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Dillon and Hidary to include the claimed limitations to reduce storage capacity limitations in the cache.

Allowable Subject Matter

Claims 8 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wright et al (US 6,442,598) – Delivering web content over a broadcast medium

Rosin et al (US 6,397,387) – Client and server system

Peterson et al (US 6,594,682) – Scheduling delivery of web content

Portuesi (US 5,774,666) – Displaying uniform network resource locators

Leak et al (US 6,182,072) – Generating a tour of WWW sites


Burner et al (US 6,282,548) – Displaying supplemental content with web page

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Srivastava whose telephone number is (703) 305-4038. The examiner can normally be reached on Monday – Friday from 9 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vs 3/5/05


VIVEK SRIVASTAVA
PRIMARY EXAMINER